AF/2827

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

GARY P. MORRISON ET AL.

Serial No. 10/034,827 (TI-31373)

Filed January 3, 2002

For: CHIP-SCALE PACKAGES STACKED ON FOLDED INTERCONNECTOR FOR VERTICAL ASSEMBLY ON SUBSTRATES

Art Unit 2827

Examiner James M. Mitchell

Customer No. 23494

Mail Stop AF
Director of the United States
Patent and Trademark Office
P. O. Box 1450
Alexandria, VA 22313-1450

CERTIFICATE OF MAILING OR TRANSMISSION UNDER 37 CFR 1.8

I hereby certify that the attached document is being deposited with the United States Postal Service with sufficient postage for First Class Mail in an envelope addressed to Director of the United States Patent and Trademark Office, P.O. Box 1450,, Alexandria, VA 22313-1450 or is being facsimile transmitted on the date indicated below:

9-26-06

Jay M. Cantor, Reg. No. 19,906

REQUEST FOR RECONSIDERATION AND REHEARING

Request is hereby made for reconsideration and/or rehearing of the Decision in the subject appeal.

It is initially noted that appellants do not claim priority based upon their provisional application and this appeal is not based upon any such allegation.

Furthermore, while appellants have the right to swear back of the Inaba reference under 37 C.F.R. 1.131, appellants further allege and have chosen an alternative procedure to eliminate Inaba as a valid reference in this appeal under the law as set forth in Pfaff v. Wells Electronics, Inc., 525 U.S. 55, 48 USPQ2d 184 (1998)(hereinafter Pfaff), as is their right.

The Supreme Court of the United States clearly stated in Pfaff commencing at section II:

> "[t]he primary meaning of the word 'invention' in the Patent Act unquestionably refers to the inventor's conception rather than to a physical embodiment of that idea. The stature does not contain any express requirement that an invention must be reduced to practice before it can be patented."

It is clear, according to 35 U.S.C. 102 that "[a] person shall be entitled to a patent unless—" and then provides limitations on patentability are set forth as items (a) through (g). Of these items (a) through (g), it is clear that items (c) and (e) through (g) have no application in this case. Items (a), (b) and (d) commence with the terms "the invention". It follows that the term "invention" is involved in each of these clauses of section 102 and the term "invention" must be defined as expressly stated by the Supreme Court in Pfaff as quoted above. The Supreme Court expressly stated that the term "invention" applies to the Patent Act, this meaning 35 U.S.C. in its entirety. There are no qualifications in the statement by the Supreme Court. Therefore, there is no limitation to the meaning of "invention" as applied to any section of the Patent Act according to Pfaff. Based upon the definition of "invention" as set forth in Pfaff, the Supreme Court established that an invention exists when "the inventor had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention" or when it is "ready for patenting".

There is no issue in this case that the appellants "had prepared drawings or other descriptions of the invention that were sufficiently specific to enable a person skilled in the art to practice the invention". The facts are that the provisional application referred to in the Decision (provisional application 60/258,528) fully provided drawings and description sufficient to meet the requirements of 35 U.S.C. 112 since the provisional application is

substantially the same if not identical to the subject application and there is no rejection of record based upon 35 U.S.C. 112.

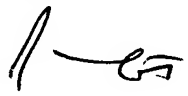
Pfaff relates to the establishment of an on-sale bar to patentability under 35 U.S.C. 102(b) and therefore deals directly with section 102 of the Patent Act. The fact that the issue in Pfaff differs from that of the present appeal in no way alters the definition of "invention" under section 102 in the present appeal.

To show that an applicant's invention predated a publication applied against the claims under 35 U.S.C. 102(a), it is merely necessary to clearly demonstrate that the applicant was in possession of the inventive concept in a form "ready for patenting" prior to the date of the publication in issue. This fact has clearly been demonstrated without question by the fact that the provisional application predates the publication advanced, namely Inaba, and the fact that the provisional application contains the invention in "ready for patenting" form as required by the Supreme Court and by 35 U.S.C. 112, first paragraph.

In view of the above and the arguments presented in the Brief on Appeal and the Reply Brief, it is readily apparent that Inaba (JP-2001-217388) is not available as a reference under 35 U.S.C. 102(a) in view of the definition of "invention" under 35 U.S.C 102 by the U.S. Supreme Court in Pfaff and, accordingly, the rejection is without merit. For the above stated reasons, reconsideration and rehearing of the Decision on Appeal is requested that the

final rejection be reversed and the rejected claims be allowed that justice be done in the premises.

Respectfully submitted,



Jay M. Cantor
Reg. No. 19906
(301) 424-0355
(972) 917-5293